

In the Drawings

The drawings are objected to the by the examiner under 37 CFR § 1.83(a) as not showing every feature of the claimed invention. To solely avoid the drawing changes required, and not based on any prior art showing, Applicant has canceled Claim 6 below. As a result, Applicant believes no further drawing changes are required by the examiner.

REMARKS

Claim 6 has been canceled in this Response to solely avoid the drawing changes required, and not based on any prior art showing.

Reconsideration is requested of the 35 U.S.C. § 103(a) rejection of claims 1-20 as being obvious to one skilled in the art over U.S. Patent No. 5,434,359 to Schell in view of U.S. Patent No. 2,775,812 to Mohr.

Regarding Claim 1, the examiner states that Schell includes a connector port that is “not mentioned but clearly shown in figures 2 and 3, notice the circular opening in the rear face 40.”

It is respectfully submitted that the circular member shown in the center of rear face 40 is merely an injection molding or stamping indentation and not an opening. The specification of Schell makes clear that the wire entrance area for the electrical box occurs at cable clamps 90 which electrical wires (not shown) therethrough . . .” (See Column 6, Lines 34-35). In addition, no connector port is taught, shown, or described in Mohr, either. This element of Claim 1 is simply not found in the art cited by the examiner.

Further, the examiner admits that Schnell lacks at least one impression member spaced from the rear face such that an outline is made, at least partially, of the rear face when pressed against the wall. The examiner goes on to assert that Mohr includes “at least one impression member (25d) spaced from the rear face such that an outline is made, at least partially of the rear surface when pressed against the wall (see figure 10 or column 2 lines 17-24 or column 5 lines 16-25).”

The Mohr electrical box is installed to a stud of a structure prior to any sheetrock or wallboard being set in place. Sharp prongs (25d) are integrally formed with and extend from the front edge of the electrical box to pierce the wallboard when the wallboard is placed over the electrical box. Mohr does not teach, show, or suggest the pressing of an electrical box against an installed wall. Rather, Mohr teaches the use of prongs or bards that are sized to be greater than the average thickness of wall board so that when the wallboard is installed after the electrical box, the prongs extend through the wallboard and are partially exposed on the outside of the wallboard.

As stated by the Federal Circuit: “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). There is no teaching, suggestion or motivation to combine Schell and Mohr because Schell is installed after the wallboard is installed (an “old work” application as it is known in the art) and Mohr is installed prior to the wallboard being installed (a “new work” application as it is known in the art). The rectangular cutout 12 shown in FIG. 1 of Schell is already made prior to the electrical box 10 being placed within the wall 14. There is no motivation to combine two different applications—old work and new work—for the cited references. In addition, neither Schell nor Mohr teach, show or describe all the elements required by Claim 1.

Claims 2-7 depend from Claim 1 and provide further limitations. Claim 6 has been canceled for drawing purposes. It is axiomatic that if the broader independent claim is not

anticipated or made obvious in light of the prior art, then neither are the dependent claims that append therefrom.

In reference to Claim 8, the examiner admits that Schnell lacks at least one impression member secured to the electrical closure apparatus such that a two-dimensional outline is made, at least partially, of the recessed portion when the impression member is pressed against the wall. The examiner goes on to assert that Mohr includes “at least one impression member (25d) spaced from the rear face such that an outline is made, at least partially of the rear surface when pressed against the wall (see figure 10 or column 2 lines 17-24 or column 5 lines 16-25).”

The Mohr electrical box is installed to a stud of a structure prior to any sheetrock or wallboard being set in place. Sharp prongs (25d) are integrally formed with and extend from the front edge of the electrical box to pierce the wallboard when the wallboard is placed over the electrical box. Mohr does not teach, show, or suggest the pressing of an electrical box against an installed wall. Rather, Mohr teaches the use of prongs or bards that are sized to be greater than the average thickness of wall board so that when the wallboard is installed after the electrical box, the prongs extend through the wallboard and are partially exposed on the outside of the wallboard.

As stated by the Federal Circuit: “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). There is no teaching,

suggestion or motivation to combine Schell and Mohr because Schell is installed after the wallboard is installed (an “old work” application as it is known in the art) and Mohr is installed prior to the wallboard being installed (a “new work” application as it is known in the art). The rectangular cutout 12 shown in FIG. 1 of Schell is already made prior to the electrical box 10 being placed within the wall 14. There is no motivation to combine two different applications—old work and new work—for the cited references. In addition, neither Schell nor Mohr teach, show or describe all the elements required by Claim 8.

Claims 9-13 depend from Claim 8 and provide further limitations. It is axiomatic that if the broader independent claim is not anticipated or made obvious in light of the prior art, then neither are the dependent claims that append therefrom.

Regarding Claim 16, the examiner admits that Schnell lacks at least one impression member for making an outline on the wall when the impression member is pressed against the wall. The examiner goes on to assert that Mohr includes “at least one impression member (25d) spaced from the rear face such that an outline is made, at least partially of the rear surface when pressed against the wall (see figure 10 or column 2 lines 17-24 or column 5 lines 16-25).”

The Mohr electrical box is installed to a stud of a structure prior to any sheetrock or wallboard being set in place. Sharp prongs (25d) are integrally formed with and extend from the front edge of the electrical box to pierce the wallboard when the wallboard is placed over the electrical box. Mohr does not teach, show, or suggest the pressing of an electrical box

against an installed wall. Rather, Mohr teaches the use of prongs or bards that are sized to be greater than the average thickness of wall board so that when the wallboard is installed after the electrical box, the prongs extend through the wallboard and are partially exposed on the outside of the wallboard.

As stated by the Federal Circuit: “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998). There is no teaching, suggestion or motivation to combine Schell and Mohr because Schell is installed after the wallboard is installed (an “old work” application as it is known in the art) and Mohr is installed prior to the wallboard being installed (a “new work” application as it is known in the art). The rectangular cutout 12 shown in FIG. 1 of Schell is already made prior to the electrical box 10 being placed within the wall 14. There is no motivation to combine two different applications—old work and new work—for the cited references. In addition, neither Schell nor Mohr teach, show or describe all the elements required by Claim 8.

Claims 17-20 depend from Claim 16 and provide further limitations. It is axiomatic that if the broader independent claim is not anticipated or made obvious in light of the prior art, then neither are the dependent claims that append therefrom.

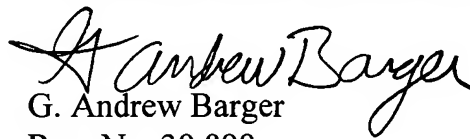
Upon entrance of this amendment, claims 1-5, 7-20 remain in the application. Claim 6 has been canceled. No new claims have been added.

The Office Action of November 9, 2004 has been reviewed and carefully considered. It

is respectfully submitted that the present Response traverses or overcomes all bases of rejection, the Application is now in suitable form for allowance, and the claims as set forth are neither taught, suggested, nor rendered obvious by the references cited by the examiner.

The examiner is invited to contact Applicant's attorney at the number below if there are any questions.

Respectfully submitted,
Thomas & Betts International, Inc.



G. Andrew Barger

Reg. No. 39,899

Customer No.: 27361

c/o G. Andrew Barger, Esq.
THOMAS & BETTS CORPORATION
Legal Department 4B-36
8155 T&B Boulevard
Memphis, Tennessee 38125

A/C (901) 252-5648